

REMARKS

The Examiner rejected claims 1-11, 14-18 and 20 under 35 U.S.C. § 102(b) as being anticipated by Leaphart, Jr. (U.S. Patent No. 6,484,326). The Examiner rejected claims 12, 13 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Leaphart in view of Rau (U.S. Patent No. 5,249,311). In response, the Applicant has amended certain claims, cancelled certain claims and has set forth arguments supporting the patentability of the remaining claims over Leaphart and Rau. The Applicant believes the amendments made in response to the Examiner's rejections have placed the application in position for allowance.

Amendments to the Claims

Applicant has amended claims 1, 10, 15 and 20 to address the Examiner's rejection under 35 U.S.C. § 102(b). Specifically, Applicant is amending these claims as set forth below:

a) claim 1 - amending this claim to clarify that both the first and second handles extend outwardly from the handle body in a generally perpendicular direction that is substantially opposite from each other and that the vertical offset between the two handles is fixed when they are attached to the handle body. This amendment is supported by the text and drawings of the disclosure.

b) claim 10 - amending this claim to incorporate the limitations of claims 2 through 9, which are being cancelled in this amendment.

c) claim 15 - amending this claim to incorporate the limitations of claims 16 and 17, which are being cancelled in this amendment.

d) claim 20 - amending this claim to incorporate the limitations of the amended claim 1 and original claims 13 and 14.

Rejection under 35 U.S.C. § 102(b)

With regard to the rejection of claims 1-11, 14-18 and 10 under 35 U.S.C. § 102(b) as being anticipated by Leaphart, the Applicant respectfully disagrees with the Examiner (the claims as

RESPONSE/AMENDMENT

Appl. # 10/712,564

1 amended herein). Leaphart does not disclose each and every element of Applicant's claimed invention  
2 as required for a Section 102(b) rejection. (Lindemann Maschinenfabrik GMBH v. American Hoist &  
3 Derrick Co., 221 USPQ 481, 485 (Fed. Cir. 1984); W.L. Gore & Associates, Inc. v. Garlock, Inc., 220  
4 USPQ 303, 313 (Fed. Cir. 1983).) In particular, Leaphart does not disclose the use of a pair of operative  
5 handles that extend outwardly in opposite directions from the handle body and which have a fixed  
6 vertical offset that remains fixed during use of the drain plunger handle.

7           Leaphart discloses a drain plunger handle that has a pair of T-shaped, or non-vertical  
8 offset operative force grips/handles 14 that are attached to the upper handle body 3. Handles 14 are  
9 utilized for the function of the device of Leaphart and are not vertically offset as disclosed and claimed  
10 by Applicant (i.e., as set forth in claim 1). The only vertical offset between "handles" in Leaphart is  
11 between the operative handles 14 and the alignment handle 4. As set forth in the disclosure of Leaphart  
12 at column 3, lines 47-62, the user utilizes alignment handle 4 only for the purpose of positioning the seal  
13 disk 13 over the drain. Once positioned, the user places his or her hands on force grips or handles 14 to  
14 push downward, which is the same function that is accomplished by the user by utilizing the first handle  
15 member and second handle member of Applicant's invention (i.e., downward force) - except that  
16 Applicant's two handles are vertically offset to better obtain the desired downward force. Even if grips  
17 14 and alignment handle 4 are considered vertically offset handles similar to Applicant's invention,  
18 which Applicant disagrees, then it is clear that the vertical offset is not fixed in Leaphart, as is set forth  
19 in Applicant's amended claim 1. In Leaphart, the inventor utilizes the handle to compress air into the  
20 drain so as to force a clog downward. The alignment handle 4 remains in place on the lower handle  
21 body 2, is configured to be telescopically received inside the upper handle body 3 such that the  
22 downward force against force handles 14 will force air through the hollow lower handle body 2 and out  
23 spout 11. It is clear that the handles 14 and 4, to the extent they are considered equivalent function  
24 handles, do not and cannot remain in a fixed vertical relationship, as the force grips/handles 14 move  
25 downward towards alignment handle 4 (as shown in Figures 1 and 2). In addition, "handles" 14 and 4  
26 are not attached to the same handle body (even if it was a multiple piece body, it is not a continuous

body). Naturally, the drain plunger handle of Leaphart could not properly function if it was a continuous or even interconnected body. In order to obtain the necessary force of air out spout 11, the upper handle body must be in a telescoping relationship with the lower handle body. Although the handle body of Applicant's invention could be a multiple piece component, it is clear that these components would not move relative to each other and that the first handle member and second handle member would remain in their fixed vertical offset.

In order to serve as a reference under 35 U.S.C. § 102(b), the reference must be enabling as to the features to which anticipation is suggested. (Akzo N.V. v. U.S. Int'l Trade Comm., 1 USPQ2d 1241, 1245 (Fed. Cir. 1986); In re Donohue, 226 USPQ 619, 621-22 (Fed. Cir. 1985); W.L. Gore & Associates, Inc., 220 USPQ at 314.) Anticipation cannot be predicated on mere conjecture regarding the characteristics of various features of the invention disclosed in the reference. (See W.L. Gore & Associates, Inc., 220 USPQ at 314.) With regard to Applicant's invention, Leaphart does not disclose a pair of vertically offset handle members that have a fixed vertical offset when attached and during use of the invention. As set forth above, either the operative force grips/handles 4 are not vertically offset or the vertical offset between force grips/handles 4 and alignment handle 14 does not remain fixed. In order for the compressed air capability of Leaphart to function, which is the objective of Leaphart's tool, it is necessary that the force grips/handles 4 move towards alignment handle 14. Therefore, it is Applicant's position that amended independent claims 1, 15 and 20 are not, respectfully, anticipated by the patent of Leaphart.

#### Rejection under 35 U.S.C. § 103(a)

With regard to the obviousness rejections for claims 12, 13 and 19, which are based on Leaphart in view of Rau, Section 103(a) only denies patentability to those inventions whose "subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." (35 U.S.C. § 103.) Initially, Applicant believes the amendments to the independent claims from which these claims depend are allowable,

1 making the dependent claims also allowable. In addition, as stated by the court in In re Geiger, 2  
2 USPQ2d 1276 (CAFC 1987), “[o]bviousness cannot be established by combining the teachings of the  
3 prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the  
4 combination.” (In re Geiger, 2 USPQ2d at 1278.) The motivation or suggestion to combine references  
5 must exist, otherwise the determination of obviousness involves nothing more “than indiscriminately  
6 combining prior art.” (Micro Chemical Inc. v. Great Plains Chemical Co., 41 USPQ2d 1238, 1244  
7 (CAFC 1997).) In In re Fritch, 23 USPQ2d 1780 (CAFC 1992), the Federal Circuit stated the  
8 following:

9 In proceedings before the Patent and Trademark Office, the Examiner bears the burden of  
10 establishing a prima facie case of obviousness based upon the prior art. The Examiner can satisfy  
11 this burden only by showing some objective teaching in the prior art or that knowledge generally  
12 available to one of ordinary skill in the art would lead that individual to combine the relevant  
13 teachings of the references.

14 Obviousness cannot be established by combining the teachings of the prior art to produce the  
15 claimed invention, absent some teaching or suggestion supporting the combination. Under  
16 section 103, teachings of references can be combined *only* if there is some suggestion or  
17 incentive to do so. Although couched in terms of combining teachings found in the prior art, the  
18 same inquiry must be carried out in the context of a purported obvious "modification" of the  
19 prior art. The mere fact that the prior art may be modified in the manner suggested by the  
20 Examiner does not make the modification obvious unless the prior art suggested the desirability  
21 of the modification.

22 Here, the Examiner relied upon hindsight to arrive at the determination of obviousness. It is  
23 impermissible to use the claimed invention as an instruction manual or "template" to piece  
24 together the teachings of the prior art so that the claimed invention is rendered obvious. This  
25 court has previously stated that one cannot use hindsight reconstruction to pick and choose  
26 among isolated disclosures in the prior art to deprecate the claimed invention. ( In re Fritch, 23  
27 USPQ2d at 1783-84 (internal quotes and citations removed).)

28 Respectfully, nothing suggests combining the teachings of Leaphart with Rau or with  
29 knowledge commonly known in the art to arrive at Applicant’s invention. Nothing in either the Leaphart  
30 or Rau references, or any knowledge generally available to one of ordinary skill in the art, compels,  
31 teaches, suggests or even offers any incentive such that an individual wanting to have a drain plunger  
32 handle with the attributes of Applicant’s invention would combine the compressed air tool with the fluid  
33 pressure device of Rau. (See In re Fritch, 23 USPQ2d at 1783; In re Geiger, 2 USPQ2d at 1278.)

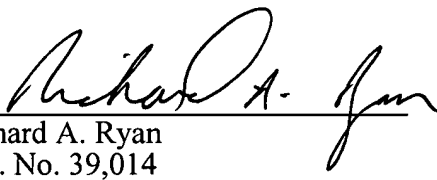
1 In light of the above amendments and arguments, Applicant respectfully requests the  
2 Examiner to withdraw the rejection of the claims remaining, as amended, in the subject patent  
3 application.

4 Applicant's original application included fees for three independent claims and a total of  
5 twenty claims. No claims are being added and ten claims are being deleted, therefore, after this  
6 amendment a total of ten claims, including three independent claims, are pending in this application. No  
7 additional fees for claims are believed due.

8 In view of the foregoing, it is submitted that this application is in condition for allowance.  
9 Reconsideration of the rejections and objections in light of this Amendment is requested. Applicant  
10 believes that the amended claims are in condition for allowance. Allowance of claims 1, 10-15 and 18-  
11 20 is respectfully solicited.

12  
13 Dated: November 7, 2005

14 Respectfully Submitted,

15  
16 By   
17 Richard A. Ryan  
Reg. No. 39,014

18 8497 N. Millbrook, Suite 101  
19 Fresno, CA 93720

20 Phone: (559) 447-1837  
21 Fax: (559) 447-1042  
22 e-mail: richard@fresnopatentlaw.com